

REMARKS

In response to the Office Action dated April 22, 2003, the Applicants have responded to the Examiner's final rejection of the claims below. Claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 are pending in the application.

In Paragraph 2 of the Office Action, the Examiner states that the Applicant's arguments with respect to claims 1, 7-12, 15-17, 19, 23, 25, and new claims 32-48 have been considered but are moot in view of the new ground(s) of rejection. In Paragraph 7 of the Office Action, the Examiner states that Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicants respectfully submit that the Examiner has not given any new grounds for rejection. The grounds given for rejection in the Office Action mailed on April 22, 2003 are the same grounds given by the Examiner in Paragraphs 4 and 5 of the Office Action mailed on December 18, 2002.

In Paragraph 4 of the Office Action mailed on December 18, 2002, the Examiner rejected claims 1-3, 5-16, and 27-31 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Raith (US 6,493,550). In Paragraph 5 of the Office Action mailed on April 22, 2003, the Examiner rejected claims 1, 7-12, 15-16, 32-41 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Raith (US 6,493,550).

In Paragraph 5 of the Office Action mail on December 18, 2002, the Examiner rejected claims 17-26 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Lachance (US 6,246,882) and Raith (US 6,493,550). In Paragraph 6 of the Office Action mail on April 22, 2003, the Examiner rejected claims 17, 19, 23, 25 and 42-48 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Lachance (US 6,246,882) and Raith (US 6,493,550).

Applicants respectfully submit that the Examiner has not provided any new grounds for rejection of the claims and that the issuance of a final rejection was not proper. *See* M.P.E.P. § 706.07(a) (8th ed. 2001). With regard to both of the grounds for rejection provided by the Examiner, no new references have been cited and in both instances the Examiner has rejected the claims based on 35 U.S.C. §103(a). Furthermore, the Examiner has failed to respond to the Applicants traversal of the Examiner's rejection that was submitted in the Applicants' prior response mailed on January 30, 2003. In that response, Applicants submitted that the Examiner's combination of the references cited in the Office Action mailed on December 18, 2002 failed to establish a *prima facie* case of obviousness concerning the invention disclosed by the Applicants for various grounds and that the Examiner's rejection should be withdrawn. Applicants acknowledged that the claims had been amended, but that the failure to establish a *prima facie* case of obviousness based on the grounds and references cited by the Examiner applied nonetheless. Where an applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. *See* M.P.E.P. § 707.07(f) (8th ed. 2001). The Examiner has repeated the same rejection provided in the previous Office Action; therefore, the Examiner should have responded to the substance of the

Applicants traversal of the rejection based on the Examiner's failure to establish a *prima facie* case of obviousness based on the grounds and references cited by the Examiner. The Examiner's failure to respond to the Applicants' traversal of the Examiner's rejection results in the Applicants being unable to readily judge the advisability of an appeal. See M.P.E.P. § 706.07 (8th ed. 2001). Therefore, the Applicants respectfully submit that the Examiner should respond to the Applicants arguments submitted with the previous response and answer the substance of the Applicants arguments. The Applicants traversal of the Examiner's rejection is applicable to both the grounds provided in the Office Action mailed on December 18, 2002 and the Office Action mailed on April 22, 2003.

Based on the foregoing, Applicants respectfully submit that the issuance of a final rejection was premature. See M.P.E.P. § 706.07(c) (8th ed. 2001). Applicants respectfully request that the Examiner reconsider the finality of the Office Action mailed on April 22, 2003, and that the finality of the rejection be withdrawn. See M.P.E.P. § 706.07(d) (8th ed. 2001).

Applicants request further examination and reconsideration of the application. Applicants resubmit that the combination of the references cited in both the Office Action mailed on December 18, 2002 and the Office Action mailed on April 22, 2003 fail to establish a *prima facie* case of obviousness concerning the invention disclosed by the Applicants for the grounds provided below and that the Examiner's rejections should be withdrawn. See M.P.E.P. § 2142 (8th ed. 2001).

The Examiner has combined the Grube and Raith references. However, the two references are not combinable. Grube discloses a communication system where a communication can be switched from a system mode of operation to a direct mode of operation when the distance relationship between the units involved in the communication is obtained, at Abstract. A communication resource controller determines the geographic separation of the units, at column 2, lines 53-67. When the desired distance relationship is met, the communication resource controller transmits a mode change message to the units to switch communication modes, at column 2, lines 20-23. The intended purpose and function of the invention is to allow two mobile units to communicate directly with each other when they are within a certain distance of each other to minimize the use of communication system resources, wherein the distance is determined by a resource controller. Raith concerns the use of a proximity detector to recognize the presence of a private radiocommunication system, Abstract. A proximity system emits a signal for detection by a mobile station, column 3, lines 12-14. The signal is emitted in order to assist a mobile station in switching from a public radiocommunication system to a private radiocommunication system, column 3, lines 12-27. The invention disclosed in Raith concerns the type of communication system utilized by a mobile unit, and requires the use of a proximity system and signal to alert the mobile unit that a stationary private communication system is available. Raith does not concern facilitating direct communication between two mobile units to minimize the use of system resources on a communication system; Raith concerns locating a private communications system to begin using the resources of another communication system. Raith has nothing to do with minimizing the use of system resources. Therefore, the combination of Grube and Raith would destroy the intended purpose and function of the invention disclosed in Grube and is not proper. A *prima*

facie case of obviousness, therefore, cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

There is also no basis to combine or modify the Grobe and Raith references. The prior art does not suggest the desirability of the combination. See M.P.E.P. § 2142 (8th ed. 2001); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). One of ordinary skill in the art would not have found it obvious to combine the teachings of Grube and Raith at the time the invention was made. See *In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987). Grube discloses an invention to encourage direct communication of mobile units in order to conserve the system resources that are available on a communications network. Raith concerns the location and use of a private communications network verses a public communications network. The invention disclosed by Grube seeks to avoid using system resources while the invention in Raith seeks to assist in using the resources of another system. There would be no motivation to modify the invention as described in Grube that encourages direct communication between mobile units to incorporate the invention described by Raith that seeks to encourage the use of resources on another system. For these reasons, the combination of Grobe and Raith cannot be properly made and a *prima facie* case of obviousness cannot be established.

Likewise, there is no basis to combine or modify the Grobe and Lachance references. The prior art does not suggest the desirability of the combination. See M.P.E.P. § 2142 (8th ed. 2001); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). One of ordinary skill in the art would not have found it obvious to combine the teachings of Grube and Lachance at the time the invention was made. Lachance discloses a system and method for tracking items using an item identifier, at column 1, lines 52-58. When an item is moved past a handling zone, an item identification reader detects the item identifier and utilizes a mobile station to the tracking system, at column 1, lines 58-67. The invention disclosed in Lachance does not concern encouraging direct communication between mobile units. Lachance concerns tracking items and relaying that information to a database using a cellular network. There would have been no motivation to modify the invention as described in Grube that encourages direct communication between mobile units to incorporate the tracking system described by Lachance. For these reasons, the combination of Grobe and Lachance cannot be properly made and a *prima facie* case of obviousness cannot be established.

For the foregoing reasons, Applicants respectfully submit that independent claims 1, 11, 17 and 23, and the claims that are dependent therefrom, are not taught by Grobe, Raith, or Lachance and are patentable over Grobe in view of Raith and Grube in view of Lachance and Raith.

In Paragraph 3 of the Office Action, the Examiner objected to Claim 17 because of informalities in the claim. Applicants have amended claim 17 to change the word "active" to "activate" to overcome the Examiner's objection.

Applicants hereby request further examination and reconsideration of the application, in view of the foregoing amendment and remarks.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was a narrowing amendment made to distinguish over a specified reference or references.

The Commissioner is hereby authorized to charge payment of any additional filing or application fees associated with this communication or credit any overpayment to Deposit Account No. 13-4365.


Attached hereto is a marked-up version of the changes made to the claims by the current amendments. The attached page is captioned "Version with markings to show changes made."

Applicants believe the foregoing amendment places the application in condition for allowance. Entry of the amendment and allowance of the application at an early date is respectfully requested.

For the foregoing reasons, the Applicants respectfully submit that claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 are now in condition for allowance. Reconsideration and withdrawal of the rejection is requested. Allowance of claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 at an early date is respectfully requested.

If the Examiner has any questions about the present Amendment or anticipates finally rejecting any claim of the present application, a telephone interview is requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claim 17 was amended.

17. (Four times amended) A method of generating a control signal comprising the steps of:
- receiving, at a location server, an initiation signal from a first mobile radio terminal, said initiation signal including the location of the first mobile radio terminal;
 - transmitting, by the location server, a location query to a second mobile radio terminal;
 - reporting, by the second mobile radio terminal, the location of the second mobile radio terminal in response to the location query;
 - comparing, at the location server, the locations of the first and second mobile radio terminals; and
 - generating a control signal based upon said comparing and transmitting the control signal from the location server to the first mobile radio terminal to activate[active] the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are either within, or separated by, a specified distance.